

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-19 remain in this application.

Claims 1-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sawahashi *et al.* (U.S. 5,590,409) in view of Bontu *et al.* (U.S. 6,418,137). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites a “transmission power control step range changer which changes a transmission power control step range corresponding to the transmission power control bit based on the detected communication state”. Claim 10 recites similar limitations at lines 10-14. The Examiner admits that Sawahashi does not teach this element of claims 1 & 10, and thus cites Bontu as teaching this element at col. 1, lines 55-64). However, a close reading of this section does not support the Examiner’s interpretation.

Bontu does not teach any means of changing a transmission power control step range. Instead, the reference teaches incrementing or decrementing a transmitted power by a single range of $\pm 0.5\text{dB}$. In fact, the Examiner admits this on page 3 of the Office action, when the Examiner states that Bontu teaches providing a varying power transmission power by a “small step size such as $\pm 0.5\text{dB}$ ”. The Examiner does not point out any teaching where this range is changed. Thus, the reference does not teach the step range changer of the invention.

At the personal interview conducted on September 14, 2004, applicant’s representative explained in detail that the claim requires the means to change this step range, yet the Examiner again cites a reference that does not teach any such step range change.

Accordingly, claims 1 and 10 are patentable over the references, even if combined. Claims 2-9, which depend on claim 1, and claims 11-19, which depend on claim 10, are thus patentable over the references for at least the same reasons as the parent claim.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). The Examiner merely cites an advantage of the secondary reference as a reason for modifying the primary reference. This is not proper motivation, because every secondary reference will have some advantage.

The Examiner must find some motivation for adding the feature of the secondary reference to the primary reference beyond some generalized benefit.

To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘*as a whole*’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

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If there are any additional fees resulting from this communication, please charge same to our
Deposit Account No. 16-0820, our Order No. 33220.

Respectfully submitted,
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